



Attorney Docket: 65043-0038

a¹ breaking said fortune cookie.

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PATENT

TECHNOLOGY CENTER R3700

REMARKS

Applicant has carefully reviewed the Office Action mailed 6/28/02 (paper no. 3) and thanks Examiner Mendiratta for the detailed review of the pending claims. Applicant has amended claim 11. No new matter has been added. Accordingly, claims 1-11 remain pending in this application. Applicant respectfully requests reconsideration of the present application in view of the above amendments and the following remarks.

Claim Rejections Under 35 U.S.C. §103

Claims 1, 3-6, 8, 10, 11, 13 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mueller (U.S. Patent No. 3,770,278). The Examiner argues that the Mueller patent teaches a strip of paper in a fortune like cookie having printed matter. The Examiner further asserts that the only difference between applicant's strip and Mueller is the meaning and information conveyed by the printed matter which is unpatentable, according to Ex parte Breslow, 192 USPQ 431. Applicant respectfully traverses the rejection.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. However, the Mueller patent does not teach or suggest all of the features of the claimed invention. While Mueller teaches the combination of a word puzzle on a strip of paper within a fortune cookie, it does not teach the combination of the claimed card game on a strip of paper within the fortune cookie. The only obvious variation that the Mueller patent teaches or suggests is a change in the subject matter of the written composition on the strip of paper. Such a change in the wording does not change the essence of the game disclosed in Mueller, which is a word puzzle.

In contrast, Applicant's claimed game includes indicia of playing cards. Such a game is not taught, nor suggested by the Mueller patent. There is no obvious correlation between a word puzzle game and a card game.

In addition, the word puzzle game in Mueller required a set of predetermined cookies in order to properly play the game. Thus, fortune cookies could not be randomly selected to play the word puzzle game, nor could the number of fortune cookies be increased or decreased once the predetermined set was established. In the present invention, the claimed card game does not require that the fortune cookies be manufactured or packaged as a set, but

can be randomly selected and packaged. In addition, the number of fortune cookies can be increased or decreased depending on which specific card game is being played or the number of people wanting to play. The current invention allows for greater flexibility in the manufacturing, packaging and utility of the strips of paper in the fortune cookie than the Mueller word puzzle game.

Ex parte Breslow does not establish a prima facie case of obviousness. Both inventions referenced in Ex parte Breslow involved a game board, a chance devise and a plurality of sets of cards. The two board games were based upon two different themes; however, they were in essence the same type of game structurally and functionally. In this case, Applicant has a clearly different game from that in the Mueller patent. A word puzzle and a card game are not the same type of game. Both have different functions and entertainment values. The word puzzle in Mueller requires all the pieces of the puzzle to be placed sequentially in order to tell a story upon completion. Once completed, the pieces of paper cannot be placed in a different sequence to tell a new story. The card game in the present application may only involve a portion of the cards available to play and different card games can be played using the same pieces of paper. Printed matter on material is a functional necessity for either game. However, the fact that both games require matter to be printed on a strip of paper, or other media, within a fortune cookie does not conclude that a card game is an obvious variation of a word puzzle.

Claims 2, 7, 9 and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mueller (U.S. Patent No. 3,770,278) in view of Reynolds (U.S. Patent No. 3,768,813). Applicant respectfully traverses the rejection.

Reynolds teaches perforation on strips of paper for separation. Mueller discloses sheets of paper that have printed a word or a segment of a written composition. In accordance with the game in Mueller, the words or segments must be joined with the other strips of paper in order to complete the game, not separated or discarded. Since Reynolds teaches separation of strips of paper and Mueller teaches joining of strips of paper there is no motivation to combine Mueller with Reynolds. Therefore, the combination of Mueller and Reynolds does not teach placing a strip of removable cards in a fortune cookie. Accordingly, because the combination of the Mueller patent and the Reynolds patent fail to teach or suggest the present invention, the Applicant respectfully request removal of the rejection under 35 U.S.C. §103(a).

Other Amendments and Additional Claims

Applicant has amended claim 11 to correct a typographical error found upon closer examination of the present application. Applicant believes that this amendment more clearly defines the present invention and is in no way amending this claim for patentability reasons. This amended claim does not narrow the scope of the invention.

CONCLUSION

For the foregoing reason, Applicants submit that this application is in condition for allowance. If there are any issues that the Examiner feels can be resolved by telephone conference, he is encouraged to telephone the undersigned representative.

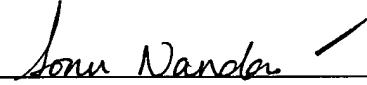
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Respectfully submitted,

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MARKED-UP VERSION

11. A novelty item comprising:
- at least one strip of paper displaying one hand unit of cards, with each said hand unit comprising one or more cards with each said card bearing the indicia of one suit and one denomination to define a card game hand; and
- a fortune cookie containing said strip so that said indicia are not visible [with] without breaking said fortune cookie.